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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,634	08/07/2007	Hermann Gruber	GRUBER-4 PCT	9684
25889	7590	02/25/2010		
COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			EXAMINER MCCARRY JR, ROBERT J	
			ART UNIT	PAPER NUMBER
			3617	
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			02/25/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/589,634	<b>Applicant(s)</b> GRUBER, HERMANN	
	<b>Examiner</b> ROBERT J. MCCARRY JR	<b>Art Unit</b> 3617	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 and 18-26 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/7/07</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "2, 23" and "25" have both been used to designate the sleeper bottom face, a bearing face and a damping mat. However the part numbers 2, 23 and 25 all appear to point to the same part in figures 1 and 3.

Reference characters 66 and 68 appear to indicate the same part of the closure element and plug in figure 1.

Reference characters 3 and 5 are used to depict the gravel bed and the longitudinal member, However I figure 1 they appear to point to the same part, that being the gravel bed and not two different portions of the assembly.

Reference characters 26 and 40 appear to indicate the same part of the mounting device and anchoring orifice in figure 1. Further reference character 26 indicating the mounting device appears to point to one part of the assembly in the left of figure 1 and a different part of the assembly on the right of figure 1.

Figure 1 is further objected for not definitively showing the claimed subject matter of the invention. At the left of figure 1, part 28 depicting the fixing elements, point to a general area of the rail and tie assembly and do not specifically point to the fixing elements. Also at the left of figure 1 reference characters 31 and 32 depicting "each side" only point to general areas of the assembly and do not definitively show the sides to be featured.

Figure 2 of the drawings is objected as multiple reference characters are shown to point to the same general area. At the upper right of figure 2 reference characters 5, 17 and 32 all used to depict different parts , point to the same general area of the assembly and do not definitively define each part associated with the reference character. Also at the top right of figure 2, reference characters 31 and 45a point to the same general area and do not definitively show the part they are to represent. Reference character 20 points to reference character 12 and also does not definitively show the part 20 is to be associated with. At the upper left of figure 2, reference characters 5, 17 and 20 all used to depict different parts , point to the same general area of the assembly and do not definitively define each part associated with the reference character. Reference character 17 is shown to be pointing to reference character 8 and does not definitively show the part it is associated with.

Figure 3 of the drawings is objected as multiple reference characters are shown to point to the same general area. At the top center of figure 3, reference characters 10 and 57 used to depict different parts all point to the same area and do not definitively show the parts they are associated with. At the upper left of figure 3 reference characters 1, 20 and 45a used to depict different parts all point to the same area and do not definitively show the parts they are associated with.

Figure 4 of the drawings is objected as multiple reference charades are shown to point to the same general area. Reference characters 31 and 32 used to show the sides of the longitudinal members appear to point to the same side of the assembly and do not definitively show the sides of the longitudinal members.

Figure 5 of the drawings is objected as multiple reference characters are shown to point to the same part of the portion at the far left of figure 5. Reference characters 26 and 28 used to show different parts of the assembly appear to point to the same part of the assembly and do not definitively show the parts they are associated with.

Figure 6 of the drawings is objected as multiple reference characters are shown to point to the same part of the portion at the far left of figure 6. Reference characters 26 and 28 used to show different parts of the assembly appear to point to the same part of the assembly and do not definitively show the parts they are associated with.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-6, 8, 13, 19, 20, and 22-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 4, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claim 5, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 5 also recites the term "two or more mounting device(s) is (are) provided in each case. This recitation appears to be narrative in nature and does not specifically state how many mounting devices are used. This leaves the claims vague and indefinite.

Regarding claim 6, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 6 also recites that the "mounting devices can be activated or deactivated". This claim is narrative in scope and does not specifically state how the mounting devices are "activated or deactivated when necessary". This leaves the claim vague and indefinite.

Regarding claim 8, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claim 9, Claim 9 recites "in a first mounting position on each side lying adjacent to the longitudinal mid-axis of the longitudinal member a rail fixing element each is secured in a mounting device". It is unclear as to exactly where on the longitudinal member the fixing elements are positioned. This leaves the claims vague and indefinite.

Regarding claim 12, Claim 12 recites "in a second mounting position on each side lying adjacent to the longitudinal mid-axis of the longitudinal member a rail fixing element each is secured to two mounting devices". It is unclear as to exactly where on the longitudinal member the fixing elements are positioned. This leaves the claims vague and indefinite.

Claim 12 recites the limitation "a second mounting position" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 13, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claim 15, Claim 15 recites "in a third mounting position, two respective rail fixing elements are secured to mounting devices on each side adjacent to the longitudinal mid-axis of the longitudinal member". It is unclear as to exactly where on

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the longitudinal member the fixing elements are positioned. This leaves the claims vague and indefinite.

Claim 15 recites the limitation "a third mounting position" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 19 recites the limitation "the shoulder surface" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 20 recites the limitation "the shoulder surface" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 22 recites the limitation "the mounting channels" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 23, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 25 recites the limitation "the support surface" in line 3. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 6-11 and 18-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Wills (US 1,696,662)



Wills discloses a railroad sleeper comprised of a cross member 17 extending along a longitudinal axis. The Examiner has interpreted the longitudinal axis to be along the center line of the sleeper and extending from the left to the right of the sleeper in figure 1. The sleeper is further comprised of two longitudinal members 10, 11 spaced apart from each other by the cross member 17. The longitudinal members 10, 11 are further comprised of a wear piece 21 in the form of a wood block and a bearing support in the form of a tie plate 26 for supporting a rail mounted on the railroad sleepers. The tie plate is positioned at the top surface of the longitudinal member so that it extends above the longitudinal member and the cross member. The longitudinal member is further comprised of a plurality of mounting devices for fixing each rail to the sleeper. The mounting devices are comprised of a plurality of channels 28 bored into the longitudinal members which accept fastening spikes to hold the rail to the longitudinal member. The mounting devices on the longitudinal members are positioned transversely offset from the center line longitudinal axis of the sleeper, as shown in figure 1. Two mounting channels are positioned on either side of the rail with the channels being parallel to each other on either side of the longitudinal axis of the sleeper and spaced a distance from each other. The mounting channels extend downward through the wear piece 21 of the longitudinal member to a depth lower than the cross member, as shown in the side view of figure 2. The channels are capable of being activated or deactivated simply by removing a spike and leaving the remaining spikes to hold the rail so long as at least one spike is positioned on either side of the rail.

The longitudinal members are constructed of a step design with the upper wear piece portion 21 being slightly smaller than the lower block 10, 11 portion of the longitudinal member. The top view of figure 1 and the side view of figure 5 both depict the step design and show that the lower portion extends about 2/3 the distance of the wear piece outward on three sides of the longitudinal member, the one side being in contact with the longitudinal cross member.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wills (US 1,696,662).

Wills discloses the railroad sleeper as disclosed above. However, Wills does not specifically show alterations for the mounting positions of the rail fixing elements. Wills only shows four spikes on either longitudinal member for fixing the rail. It would have been an obvious design choice to alter the locations and number of anchoring elements with the expected result of adjusting the mounting arrangement to accommodate various sized rails or accommodate curved rails or inclined rails when the track traverses curves or hills.

***Conclusion***

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Williams (US 1,244,813), Sweeney (US 1,381,251), Ickes (US 1,410,185) and Farnham (US 1,426,828) all disclose types of railroad sleepers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT J. MCCARRY JR whose telephone number is (571)272-6683. The examiner can normally be reached on Monday through Friday 7:00am to 3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joseph Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. Joseph Morano/  
Supervisory Patent Examiner, Art Unit 3617

/R. J. McCarry Jr./  
Examiner, Art Unit 3617

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RJM

February 22, 2010